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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,972	09/26/2001	Fu-Pao Tsao	LP/V-31598A	1540

31781 7590 06/10/2005

CIBA VISION CORPORATION  
PATENT DEPARTMENT  
11460 JOHNS CREEK PARKWAY  
DULUTH, GA 30097-1556

EXAMINER
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PETRUNCIO, JOHN M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/963,972

Applicant(s)

TSAO, FU-PAO

Examiner

John M. Petruncio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/16/03, 5/27/03

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 12 objected to because of the following informalities: A period is missing. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. 5,523,012 to Winterton et al.

The Winterton et al "012 patent reference relates to hydrogen peroxide disinfection solutions for contact lenses (col. 1, line 7) which is buffered with phosphates to the desired pH of about 6.9 to 7.1 (col. 2, lines 39-49), contains a hydrogen peroxide stabilizer such as diethylene triamine penta (methylene phosphonic acid) (col. 2, line 50 et seq), a sodium chloride tonicity component (col. 1, line 53; col. 2, line 35-36), platinum catalyst inactivation of hydrogen peroxide (col. 1, lines 46-49, col. 2, line 37), and additionally incorporates about 0.1% to about 1.0% of an ocularly compatible surface active agent (col. 2, line 1 et seq). The surface active agents can be polyoxyethylene-polyoxypropylene nonionic surfactants (col. 3, lines 4-8), generally known as "poloxamers" typically having a molecular weight between about 2000 and about 5000, and construed as surfactants called for by the second alternative structural

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formula of instant independent claim 1. Claims 1-13 are anticipated by the Winterton et al '012 patent reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 14-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. 5,523,012 to Winterton et al as applied to claims 1-13 above, and further in view of US pat. 5,411,597 to Tsao.

The Winterton '012 patent reference does not appear to specifically define the surfactant copolymer called for by instant independent claims 14, 29 and 36 . However, the Tsao et al '597 patent reference, which relates to ophthalmic contact lens disinfection, teaches the alternative use of disinfectant solutions which can contain a preferred class of surfactants including poloxamers, reverse poloxamers, merxapols

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such as Pluronic 17R4 (col. 5, line 53 et seq and col. 6, lines 3-9). These same surfactants are also disclosed as useful as viscosity enhancing agents, (see col. 7, lines 61-62 and col. 8, lines 1-5). At the time of the invention, one of ordinary skill in the art having the benefit of the Tsao et al '597 patent reference teachings of the alternative use of these surfactants, would have found it obvious to substitute the reverse poloxamers as called for by instant claim 14 for the poloxamers as disclosed by Winterton et al as Tsao et al taught the equivalency of the two in a similar contact lens disinfectant solution with the expectancy of a high degree of success. The dependent claim limitations as presently called for would be expected from incorporation of one or more of the surfactant poloxamers and/or reverse poloxamers as taught by the prior art for incorporation in the Winterton et al '012 patent reference disinfectant contact lens solutions as referred to hereinabove. . No claim stands allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Petruncio whose telephone number is 571-272-1323. The examiner can normally be reached on 10:30Am-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John M. Petruncio  
May 9, 2005

**MICHAEL BARR**  
**SUPERVISORY PATENT EXAMINER**

A handwritten signature in black ink, appearing to read 'Mike', with a long horizontal flourish extending to the right.